

New claims 23-29 have been added. Support for these new claims exists, *inter alia*, in the examples as well as at pages 5-6 and 8-9.

Claims 1-29 are currently pending.

### **REMARKS**

As noted in the present specification, compositions containing water-in-oil (W/O) emulsions have the drawbacks of giving a fairly greasy feel and providing no freshness when applied to skin. (Page 2, lines 4-7). Thus, compositions containing W/O emulsions are generally too greasy for use on greasy skin and too rich in oils for use during summer or in hot countries. (Page 2, lines 6-8). In hopes of overcoming such problems, W/O emulsions having a high water content have been desired. (Page 2, lines 9-10). However, such emulsions have not been practical because either (1) high water content causes stability problems; or (2) several surfactants or gelling agents must be added to the emulsions to compensate for the instability associated with high water content, leading to skin discomfort and/or irritation upon use. (Page 2, lines 10-14). Other W/O emulsions have lacked stability under fluctuating temperature conditions. (Page 2, line 15 through page 3, line 9).

The claimed invention addresses such problems associated with W/O emulsions. The pending claims relate to W/O emulsions containing a silicone emulsifier which is a dimethicone copolyol comprising only oxyethylene groups as oxyalkylene groups, wherein the aqueous phase is present in an amount of at least 80% by weight relative to the total weight of the emulsion and the oily phase to silicone emulsifier weight ratio is greater than or equal to 5.

These compositions, despite their high water content, are stable even when stored under conditions of fluctuating temperatures. (Page 3, lines 19-21). Moreover, the claimed

compositions have rheological characteristics such that, when applied to skin, the composition "breaks" (that is, suddenly becomes fluid under the effect of shear), thereby providing great freshness. (Page 4, lines 1-2).

Regarding the improved stability characteristics under fluctuating temperature conditions, Applicant notes the examples in the present specification demonstrate that the claimed compositions possess good stability under such conditions, whereas comparative compositions do not.

Regarding the improved rheological characteristics of the claimed compositions, Applicant submits herewith the Rule 132 declaration of Mme. Chevalier. This declaration and accompanying data demonstrate that W/O emulsions containing 80% or more aqueous phase and the claimed silicone emulsifier "break"<sup>1</sup> more readily than W/O emulsions containing less aqueous phase (70% aqueous phase). As noted in the Chevalier declaration, the ability to "break" indicates that compositions having 80% or more aqueous phase possess better fluidization properties and, hence, provide greater freshness upon application to skin than emulsions containing less aqueous phase, a "surprising and unexpected difference" between these emulsions.

The declaration and accompanying data also demonstrate that W/O emulsions corresponding to Mellul's example 24 are unacceptable for use in the cosmetic industry (that is, they are crude pastes), whereas the claimed compositions are cream products suitable for use in cosmetics. This difference was "surprising and unexpected" as well.

---

<sup>1</sup> Applicant would like to bring to the Examiner's attention that due to a printing error, the word break in quotation marks ("break") was transformed to Abreak $\cong$  in the declaration. Thus, where Abreak $\cong$  appears in the declaration, this should be "break."

Applicant submits that the improved rheological characteristics of the claimed compositions as set forth in the Rule 132 declaration, as well as the compositions' improved stability under fluctuating temperature conditions demonstrate that the claimed compositions are not obvious and, thus, deserving of patent protection.

In view of this background, each of the rejections made in the outstanding Office Action will now be addressed in turn.

#### **REJECTIONS UNDER 35 U.S.C. §112**

The Office Action rejected claims 4, 7, 11, 15, 18 and 22 under 35 U.S.C. § 112, second paragraph as being indefinite. In view of the non-narrowing, editorial amendments set forth above, Applicant respectfully submits that these rejections have been rendered moot. Accordingly, Applicant respectfully requests that these rejections be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. §103**

The Office Action rejected claims 1-21 under 35 U.S.C. § 103 as obvious over U.S. patent 5,851,539 ("Mellul"). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Initially, Applicant notes that claim 22 was not rejected under 35 U.S.C. § 103. Accordingly, Applicant respectfully submits that this claim should be allowed to issue.

With respect to the remaining claims, the Office Action admits that Mellul does not exemplify compositions containing at least 80% aqueous phase, the claimed silicone surfactant and the claimed oily phase to silicone emulsifier weight ratio. Moreover, Mellul would not lead one skilled in the art to select and combine ingredients in such a way to arrive at the claimed invention.

Mellul does not attach any significance to having 80% or more aqueous phase. Thus, according to Mellul, 70% aqueous phase is no different from 80% aqueous phase. However, as indicated in the Rule 132 declaration submitted herewith, a “surprising and unexpected difference” exists between compositions having 70% aqueous phase and the claimed compositions having 80% aqueous phase with respect to “break” properties.

Moreover, Mellul does not attach any significance to using silicone emulsifiers which are dimethicone copolyols comprising only oxyethylene groups as oxyalkylene groups. In her discussion of acceptable silicone surfactants, Mellul includes surfactants containing oxyethylenated groups as well as oxypropylenated groups. (See, for example, col. 8, line 11, et. seq., particularly line 23). However, as shown in the examples of the present specification, silicone emulsifiers containing oxyethylenated groups and oxypropylenated groups do not possess good stability under fluctuating temperature conditions. In contrast, the claimed compositions containing silicone surfactants which are dimethicone copolyols comprising only oxyethylene groups as oxyalkylene groups have good stability under such conditions.

Based on Mellul’s disclosure, one skilled in the art would not have been motivated to produce compositions containing 80% or more aqueous phase, a silicone surfactant which is a dimethicone copolyol comprising only oxyethylene groups as oxyalkylene groups and an oily phase to silicone emulsifier weight ratio greater than or equal to 5 for at least the reason that no beneficial properties resulting from such a combination would have been expected from her disclosure.

In view of the above, Applicant respectfully submits that no *prima facie* case of obviousness exists and that, accordingly, the pending rejection should be withdrawn.

Assuming *arguendo* that the January 24, 2002 Office Action has established a *prima facie* case of obviousness --which it has not-- the accompanying Rule 132 declaration and examples in the specification are more than sufficient to overcome such a hypothetical *prima facie* showing. The declaration demonstrates that W/O emulsions containing 80% or more aqueous phase "unexpectedly and surprisingly" break more readily than emulsions containing less aqueous phase, meaning that the former compositions have more aqueous phase available for contact with skin than the latter emulsions. The declaration indicates that this difference is significant because it provides W/O emulsions having 80% or more aqueous phase a fresher feeling upon application, an important characteristic in the cosmetic field. The declaration also demonstrates that compositions corresponding to Mellul's Example 24 are unsuitable for use in the cosmetic industry, unlike the claimed invention. Finally, the examples in the present specification demonstrate that compositions containing the claimed silicone surfactant are more stable under fluctuating temperature conditions than compositions containing other silicone surfactants, making the former compositions better suited for commercial production, storage and transport than the latter compositions.

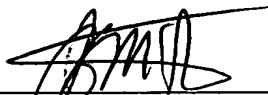
Applicant respectfully submits that the declaration and the examples in the present specification, as well as the test results disclosed therein, are more than sufficient to rebut any *prima facie* case of obviousness based upon the cited reference.

In view of the above, Applicant respectfully requests that the rejection under 35 U.S.C. §103 be withdrawn.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867



**22850**

Phone: (703) 413-3000

Fax #: (703) 413-2220

I:\user\JBMC\NL'Oreal\209060 amd.wpd



**Marked-Up Copy**

Serial No:09/884,949

Amendment Filed on:

July 24, 2002

**IN THE CLAIMS**

4. (Amended) The composition according to Claim 2, which comprises at least 70 % by weight water relative to the total weight of the composition.

7. (Amended) The composition according to Claim 2, wherein said oily phase and said emulsifier are present in a weight ratio of said oily phase to said emulsifier greater than or equal to 8.

11. (Amended) The method of Claim 9, wherein said composition comprises at least 70 % by weight water relative to the total weight of the composition.

15. (Amended) The method of Claim 9, wherein in said composition said [the] oily phase comprises one or more volatile silicone oils.

18. (Amended) The method of Claim 16, wherein said composition comprises at least 70 % by weight water relative to the total weight of the composition.

22. (Amended) The method of Claim 16, wherein in said composition said [the] oily phase comprises one or more volatile silicone oils.

Claims 23-29 (New)